UNITED STATES PATENT AND TRADEMARK OFFICE

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10/052,577	01/18/2002	Brent Magouirk	P68364	7360

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EXAMINER
LOFTIS, JOHNNA RONEE

ART UNIT	PAPER NUMBER
3623	

NOTIFICATION DATE	DELIVERY MODE
07/30/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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patent@hershkovitz.net

	Application No.	Applicant(s)
	10/052,577	MAGOUIRK ET AL.
Office Action Summary	Examiner	Art Unit	
	JOHNNA R. LOFTIS	3623	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 April 2008</u>.

2a)☐ This action is **FINAL.** 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   The following is a non-final office action upon examination of application number

10/052577. Claims 1-23 are pending and have been examined on the merits discussed below.

Response to Arguments

2.   Applicant's arguments with respect to claims rejected by Geerlings have been considered

but are moot in view of the new ground(s) of rejection. Stack has been introduced. Stack

teaches analyzing past customer purchases along with a potential customer's selection of goods

and/or service. The two types of data are used to provide recommendations. Claim rejections

are updated below.

3.   In response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., specifics of

claimed client ticket sessions) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, the

claim language is examined using the broadest reasonable interpretation. Examiner contends

that the tracking of purchasing history of Stack reads on the client ticket session since both are a

way to track the actions of the customer. It is well understood that a ticket session is some

recording of transaction data between two parties. In the instant case, the tracking in Stack reads

on the ticket session since customer purchase activities are tracked in order to facilitate the

recommended action determination.

4.   Further, in light of recent Supreme Court precedent and recent Federal Circuit decisions,

new rejections under 35 USC 101 are warranted. These rejections are listed below.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

6.   Claims 1-19 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and

recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must

(1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying

subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr,

450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson,

409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

3.   An example of a method claim that would <u>not</u> qualify as a statutory process would be a

claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim

should positively recite the other statutory class (the thing or product) to which it is tied, for

example by identifying the apparatus that accomplishes the method steps, or positively recite the

subject matter that is being transformed, for example by identifying the material that is being

changed to a different state.

        Here, applicant's method steps fail the first prong of the new Federal Circuit decision

since they are not tied to another statutory class and can be performed without the use of a

particular apparatus. Thus, claims 1-19 are non-statutory since they may be performed within the

human mind.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   **Claims 1-8, 11-15 and 21** rejected under 35 U.S.C. 103(a) as being unpatentable over

Stack, US6782370, in view of Geerlings, US 5956693.

As per **claim 1**, Stack teaches statistically analyzing a collection of data representing

historical interactions with a plurality of previous customers including at least one non-purchaser

(column 1, lines 43-67 – collection of potential customer interest in a good and/or service and

also collection of previous customer purchasing history); developing at least one recommended

action item to be taken with respect to a current customer based on results of the statistical

analysis (column 1, lines 43-67 and column 2, lines 32-67 – interest data and purchasing data are

analyzed to produce recommendations); wherein at least one of said at least one non-purchaser is

other than said current customer and past purchasers (column 1, lines 43-67 – collection of

potential customer interest in a good and/or service and also collection of previous customer

purchasing history). While Stack teaches generating recommendations, the reference fails to

explicitly teach automatically updating an electronic schedule with at least one task representing

the at least one recommended action item. Geerlings teaches this feature (column 4, line 58 –

column 5, line5 – customer activity is analyzed and a plan is formulated by the merchant for

desired customer communications, the plan including the desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the scheduling of communications regarding the recommendations as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 2**, Stack doesn't explicitly teach developing more than one recommended action item and automatically updating the electronic schedule with more than one task, wherein the electronic schedule is updated with a task that corresponds to each of the recommended action items. However, Geerlings teaches developing more than one recommended action item (column 5, lines 32-35 – the merchant schedules transmitting communications on recurring basis and column 6, lines 40-42 – reference is made to sending different communications to the same customer); and automatically updating the electronic schedule with more than one task, wherein the electronic schedule is updated with a task that corresponds to each of the recommended action items (column 5, lines 32-35 – the merchant schedules transmitting communications on recurring basis). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 3**, Stack teaches statistically analyzing a collection of data representing historical interactions with a plurality of previous customers that include at least one purchaser and at least one non purchaser (column 3, lines 50-65 – confidence matching factor is calculated to determine recommendations).

As per **claim 4**, Stack teaches developing at least one recommended action item to be taken with respect to a current customer based on at least one rule that is applied to the collection of data representing historical interactions with the plurality of previous customers (column 3, lines 50-65 – confidence matching factor is calculated to determine recommendations).

As per **claim 5**, Stack does not explicitly teach the limitations. However, Geerlings teaches developing at least one recommended action item to be taken with respect to a specific current customer based on a determination that the collection of data representing historical interactions with the plurality of previous customer shows that the specific current customer has not been contacted for a predetermined amount of time (column 5, lines 14-19 – the system analyzes how long ago a customer purchased a product in order to plan communication; if it has been more than 60 days since the purchase, communication is planned). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 6**, Stack teaches determining at least one pattern demonstrated by a group of the plurality of previous customers (column 3, lines 50-65).

As per **claim 7**, Stack teaches determining trends (column 3, lines 50-65), but does not teach the exact limitations of the claim. Geerlings teaches determining at least one trend based on environmental data characteristics (column 5, lines 6-9 – any combination of criteria based on age, gender, geographical location, shopping activity may be used to target the customer). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 8**, Stack teaches determining trends (column 3, lines 50-65), but does not teach the exact limitations of the claim. Geerlings teaches determining at least one trend based on an environmental data characteristic selected from the group consisting of product type, product cost, customer target cost, customer gender, customer age, salesperson's gender, the weather and salesperson's age (column 5, lines 6-9 – any combination of criteria based on age, gender, geographical location, shopping activity may be used to target the customer). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 11**, Stack teaches making recommendations (column 3 and column 4), But does not teach selecting an appropriate task type. Geerlings teaches determining the

recommended action item includes selecting an appropriate task type (column 4, line 58 –

column 5, line5 – customer activity is analyzed and a plan is formulated by the merchant for

desired customer communications, the plan including the desired communication (mail, email,

internet, fax, etc.) and the date or timing of when the communication is to be sent, rules for

sending offers are based on the product purchased, i.e., if a customer purchases a certain

appliance and extended warranty offer is sent to the customer). It would have been obvious to

one of ordinary skill in the art to include in the recommendation system of Stack the above

recited features as taught by Geerlings since the claimed invention is merely a combination of

old elements, and in the combination each element merely would have performed the same

function as it did separately, and one of ordinary skill in the art would have recognized that the

results of the combination were predictable.

　　　　As per **claim 12**, Stack teaches making recommendations (column 3 and column 4), But

does not teach selecting an appropriate task type. Geerlings teaches determining the

recommended action item includes selecting an appropriate task type selected from the group

consisting of sending flowers, send an email, contacting by telephone, sending a gift, sending a

newsletter and sending a gift certificate (column 4, line 58 – column 5, line 5 – customer activity

is analyzed and a plan is formulated by the merchant for desired customer communications, the

plan including the desired communication (mail, email, internet, fax, etc.) and the date or timing

of when the communication is to be sent, rules for sending offers are based on the product

purchased, i.e., if a customer purchases a certain appliance and extended warranty offer is sent to

the customer). It would have been obvious to one of ordinary skill in the art to include in the

recommendation system of Stack the above recited features as taught by Geerlings since the

claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 13**, Stack teaches making recommendations based on interest and shopping history, but does not explicitly teach the features recited in the claims. Geerlings teaches the recommended action item includes selecting a timing and frequency for the at least one task (column 4, line 58 – column 5, line5 – customer activity is analyzed and a plan is formulated by the merchant for desired customer communications, the plan including the desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 14**, Stack teaches statistically analyzing a collection of data representing historical interactions between a single sales entity and a plurality of previous customers (column 3 – column 4 - historical purchases are analyzed using confidence match factor))

As per **claim 15**, Stack teaches statistically analyzing data representing historical interactions, but does not explicitly teach the limitations of the claim. Geerlings teaches statistically analyzing a collection of data representing historical interactions between a plurality of sales entities and a plurality of previous customers (column 16, lines 13-34 – different

branches, departments and/or sites of the company utilize the system as though they are separate

merchants). It would have been obvious to one of ordinary skill in the art to include in the

recommendation system of Stack the above recited features as taught by Geerlings since the

claimed invention is merely a combination of old elements, and in the combination each element

merely would have performed the same function as it did separately, and one of ordinary skill in

the art would have recognized that the results of the combination were predictable.

As per **claim 21**, Stack teaches data representing historical interactions with the plurality

of previous customers including at least one non-purchaser are client ticket sessions (column 3,

column 4, customer purchase data is collected and retrieved for purposes of recommending

items).

9.   **Claims 9 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Geerlings, US 5,956,693.

As per **claim 9**, Stack, in combination of Geerlings, teaches scheduling desired

communication (mail, email, internet, fax, etc.) and the date or timing of when the

communication is to be sent based on the product purchased (Geerlings, column 4, line 58 –

column 5, line 5), but does not explicitly teach automatically rescheduling the task if it is not

performed as scheduled. Geerlings however teaches generating trigger statements wherein a

criterion is set that triggers an action, i.e., send a communication after a predetermined amount of

time. In view of the triggers in Geerlings, official notice is taken that it would have been obvious

to one of ordinary skill in the art at the time of the invention to generate a trigger wherein if a

communication is not sent as scheduled, i.e., network error, the communication is rescheduled to

be sent. This would ensure communications to customers are sent regardless of any glitch in the system.

As per **claim 10**, Stack, in combination with Geerlings, teaches scheduling desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent based on the product purchased (Geerlings, column 4, line 58 – column 5, line 5) but does not explicitly teach automatically re-assigning the task if it is not performed as scheduled. Geerlings however teaches generating trigger statements wherein a criterion is set that triggers an action, i.e., send a communication after a predetermined amount of time. In view of the triggers in Geerlings, official notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to generate a trigger wherein if a communication is not sent as scheduled, i.e., network error, the communication is rescheduled to be sent. This would ensure communications to customers are sent regardless of any glitch in the system.

10.   **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Geerlings, US 5,956,693, further in view of Kramer et al, US 6,327,574.

As per **claim 16**, the combination of Stack and Geerlings does not explicitly teach statistically analyzing a collection of data that has been stripped of client confidential information and represents historical interactions between a plurality of sales entities and a plurality of previous customers. However, Kramer et al teaches removing confidential consumer information while still allowing targeted marketing to take place. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the removal of

confidential consumer information, as a way to ensure customer information will not end up in

the wrong hands.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

12.   **Claims 17-20, 22 and 23** rejected under 35 U.S.C. 102(a and e) as being anticipated by

Stack, US 6782370.

As per **claim 17**, Stack teaches statistically analyzing a collection of data representing

historical interactions with a plurality of previous customers including at least one non-purchaser

(column 1, lines 43-67 – collection of potential customer interest in a good and/or service and

alos collection of previous customer purchasing history); developing at least one recommended

action item to be taken with respect to a current customer based on results of the statistical

analysis (column 1, lines 43-67 and column 2, lines 32-67 – interest data and purchasing data are

analyzed to produce recommendations); performing a task that corresponds to the at least one

recommended action item (column 3 – column 4 – books are recommended); wherein at least

one of said at least one non-purchaser is other than said current customer and past purchasers

(column 1, lines 43-67 – collection of potential customer interest in a good and/or service and

also collection of previous customer purchasing history).

As per **claim 18**, Stack teaches performing the task in response to a user directive

(column 3, column 4 – recommendation in response to user actions).

As per **claim 19**, Stack teaches automatically performing the task (column 3 – 14-28 –

once a user selects a book, the system automatically makes recommendations based on

selection).

As per **claim 20**, it is the system with means for performing the method of claim 17.

Since Geerlings teaches a computer system wherein customer data is analyzed to develop a plan

for targeted communication the same rejection as applied to claim 17 is applied to claim 20.

As per **claim 22**, Stack teaches data representing historical interactions with the plurality

of previous customers including at least one non-purchaser are client ticket sessions (column 3,

column 4, customer purchase data is collected and retrieved for purposes of recommending

items).

As per **claim 23**, Stack teaches data representing historical interactions with the plurality

of previous customers including at least one non-purchaser are client ticket sessions (column 3,

column 4, customer purchase data is collected and retrieved for purposes of recommending

items).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-

6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Beth Van Doren can be reached on 571-272-6737. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jl/
7/13/08
/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623